

wherein the discontinuous phase has a droplet size distribution range of from about 0.1 microns to about 100 microns and wherein the particles are uniformly distributed on the skin independent of skin topography. Applicants have surprisingly found that these compositions provide a natural appearance to the skin upon application since they are formulated such that agglomeration of the pigment upon application to the skin is minimized.

#### REJECTIONS UNDER 35 USC §103

Claims 1-10 and 12-14 have been rejected under 35 USC §103(a) as being unpatentable over US 5,412,004, Tachibana et al. (hereinafter "Tachibana"). The Office maintains that the limitations currently claimed by Applicants are all taught with the exception of the droplet size distribution range of the discontinuous phase, the average particle size of the emulsifying crosslinked siloxane elastomer, and the amount of air contained in the composition. The Office, however, reasons that it is within the skill in the art to select optimal parameters in a composition in order to achieve a beneficial effect. Thus, the Office believes it to be within the skill in the art to select optimal droplet size and particle size in the compositions of Tachibana for aesthetic purposes. Applicants respectfully traverse this rejection.

Tachibana discloses a silicone polymer, a paste-like composition prepared by kneading the silicone polymer and a silicone oil under a shearing force, and a water-in-oil type cosmetic composition comprising the paste-like silicone composition as an oil phase component. In particular, Tachibana discloses a silicone polymer that is prepared by the addition polymerization of components comprising an  $R^1R^2H_cSiO_{(4-a-b-c)/2}$  (1) or  $R^1H_gSiO_{(4-f-g)/2}$  and a polyoxyalkylene  $C_mH_{2m-1}O(C_2H_4O)_h(C_3H_6O)_iC_mH_{2m-1}$  or an organopolysiloxane  $R^1R^4SiO_{(4-j-k)/2}$  (B), including (1) or (A) as an essential component. The reference, however, fails to teach or suggest a composition as Applicants currently claim that includes a solid particle-containing discontinuous phase wherein the discontinuous phase has a droplet size distribution range of from about 0.1 microns to about 100 microns. Moreover, the reference fails to teach or suggest that such particles are uniformly distributed on the skin independent of skin topography. Applicants have surprisingly found that compositions as claimed that exhibit this characteristic also tend to exhibit minimized agglomeration of the solid particles and thus yield improved deposition of the overall composition onto the skin. Without being limited by theory, these solid particles are delivered to the skin by means of the claimed droplet size distribution as dispersed within the discontinuous droplet phase. Applicants

have found that the solid particles are dispersed within and/or at the droplet interface of the emulsion system such that capillary-induced agglomeration of the particles is confined within the space or volume occupied by the droplet, thereby providing a more even distribution of the broad range of particles on skin. Additionally, the droplets serve as a barrier preventing agglomeration as a result of application shear. These principles/observations are not disclosed expressly or implicitly in the Tachibana reference. In fact, Tachibana fails to teach or suggest the delivery of powder or pigmented solids via the discontinuous phase of an emulsion composition. The Office identifies that Tachibana discloses solids selected from the group consisting of sugars, sugar alcohols and inorganic salts for use in the water phase of its composition. These solids, however, are water-soluble actives that would prevent uniform deposition of such particles on the skin. Solids, such as those taught by Applicants' invention, can be identified as those that not only exhibit an average particle size less than 20 microns but are also insoluble such that delivery to the skin is optimal. One skilled in the art reading Tachibana would not appreciate the aesthetic and functional attributes achieved by Applicants' invention. Instead, a skilled artisan reading Tachibana would find that if cosmetic powders are used, they are to be deposited solely in the oil phase.

The Office believes the prior art to inherently exhibit the same properties as that which is presently claimed. Applicants respectfully submit that the Office has rejected the aforementioned claims under an assertion of obviousness yet relies on a rationale of inherency. Respectfully, it has been well settled that inherency is an anticipation rationale and when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. *See, Ex Parte Schriker*, USPTO, Board of Patent Appeals and Interferences, No. 1996-2414, Decided June 7, 2000; 56 USPQ2d 1723, 1725. Moreover, the present invention is distinguishable from the reference such that the reference cannot expressly or inherently exhibit the same properties as that which is presently claimed. Applicants teach that pigmented powders must be deposited in the internal, discontinuous, water phase as opposed to the external, continuous, oil phase exemplified by Tachibana. Furthermore, that which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown. *In re Shetty*, 566 F.2d 81, 195 USPQ 753, 757 (CCPA 1977). It is clear that one reading Tachibana would not have the knowledge to appreciate the effective aesthetics offered and discovered by Applicants' invention.

Additionally, Applicants find no teaching or suggestion in the reference of aerating the compositions disclosed therein. The Office contends that Tachibana contains at least 1% air because

it is mixed in a conventional manner. Applicants respectfully submit that the conventional mixing or kneading as described in Tachibana can be distinguished from the presently claimed invention comprising at least about 1% air. According to Hawley, G.G., The Condensed Chemical Dictionary, 11<sup>th</sup> Ed., Van Nostrand Reinhold Co., New York (1987), p.26, the term "aerate" can be defined as "[t]o impregnate or saturate a material (usually a liquid) with air, or some similar gas. This is usually achieved by bubbling the air, through the liquid, or by spraying the liquid into air." Thus, the kneading disclosed by Tachibana would not allow a defined amount of air to be impregnated into a composition as taught by Applicants' invention. Additionally, it would not have been obvious to a skilled artisan to modify Tachibana to arrive at the compositions of the present invention.

Based on the foregoing, Applicants find no teaching or suggestion in the reference to render Claims 1-10 and 12-14 obvious over Tachibana.

Claim 11 has been rejected under 35 USC §103(a) as being unpatentable over Tachibana as applied to claims 1-10 and 12-14 and further in view of Hawley, G.G., The Condensed Chemical Dictionary, 10<sup>th</sup> Ed., Van Nostrand Reinhold Co., New York (1981), pages 121, 385, 434, and 686 (hereafter "Hawley"). The Office believes that Hawley teaches the preservatives that are lacking in Tachibana's disclosure. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to add any one of the preservatives disclosed in Hawley to the composition of Tachibana for their known antimicrobial effects. Applicants traverse this rejection.

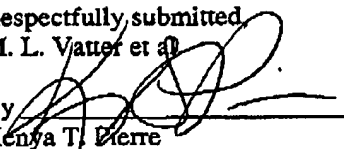
As explained above relative to Tachibana, the reference fails to disclose the requisite limitations of Applicants' invention that deal with droplet size distribution and Applicants' solid particles being dispersed within the discontinuous phase. Therefore, the mere addition of Hawley's disclosure of commonly used preservatives fails to remedy this shortcoming. Tachibana still fails to teach or suggest Applicants' presently claimed emulsion system which provides minimized agglomeration and even distribution of the broad range particles on skin for an aesthetically pleasing, natural appearance. Thus, Applicants respectfully assert that this reference's disclosure of well known preservatives when viewed in combination with Tachibana would not have rendered Applicants' invention obvious since none of the benefits of the claimed composition are taught, suggested, or even recognized by either reference. Even if one were to hypothetically combine the two references, one would still fall short of Applicants' presently claimed invention because one would not know or understand the importance of dispersing Applicants' solids within the discontinuous droplet phase.

It is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the Applicants' invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. See, *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. *In re Grabiak*, 222 USPQ2d 870, 872 (Fed. Cir. 1985). Respectfully, the cited references fail to suggest such desire. The fact that the references relate to the same area of technology is insufficient. *In re Geiger*, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Thus, Applicants assert that a rejection under 35 USC §103(a) as unpatentable over the cited references are improper and therefore request withdrawal of the rejection and reconsideration.

#### CONCLUSION

Based on the foregoing statements, Applicants respectfully submit that the Office has not made prima facie cases of obviousness and the rejections are therefore improper. Reconsideration and withdrawal of the rejections is respectfully requested. Allowance of each of the pending claims in the next Office Action is earnestly requested.

Respectfully submitted  
M. L. Vatter et al

By   
Kenya T. Pierre  
Attorney for Applicants  
Registration No. 50,165  
(513) 626-4055

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